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EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,510

Applicant(s)

TILEY ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 33-41 is/are rejected.
- 7) ☒ Claim(s) 31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-41 have been examined.

Claim Objections

Claims 1-35 are objected to because of the following informalities: In the seventh line of claim 1, "the individual" lacks antecedent basis, strictly speaking, because the previous reference is to identifying individuals, plural. Appropriate correction is required.

Claims 22-24 are objected to because of the following informalities: In the third line of claim 22, "may be comprised" is unclear, because it does not actually state that the step of motivating comprises at least one of the listed actions. Appropriate correction is required.

Claim 41 is objected to because of the following informalities: In the sixth line of claim 41, "the individual" lacks antecedent basis, strictly speaking, because the previous reference is to identifying individuals, plural. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-30, and 33-35

Claims 1, 7, 8, 9, 12, 13, 14, 15, 21, 25, 26, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al. (U.S. Patent 5,832,457) in view of Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?"). As per claim 1, O'Brien discloses (b) compiling information on an individual who will visit a retail outlet (Abstract; compiling information is held to be inherent from the existence of a database of such information); and (c) providing at least a portion of that individual information to a marketing entity for target marketing directed to the individual before, during, or after visiting the retail outlet (Abstract; columns 3 and 4), and discloses use of computers for these purposes (Figure 1; column 5, line 19, through column 6, line 15). O'Brien does not disclose that the individual intends to visit the retail outlet for pick up or return of a product shipped from a seller unrelated by ownership to that specific retail outlet, but Galler teaches providing pick-up and return services inside stores of a number of chains, presumably unrelated by ownership to the e-commerce merchants who sell the products delivered to those stores (see five paragraphs beginning from

"PackageNet, a Fairfield, Iowa, company"). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to compile information on, and provide it to a marketing entity for target marketing directed to, individuals intending to visit a specific retail outlet to pick up a product shipped from a seller unrelated by ownership to that specific retail outlet, for the obvious advantage of profiting from the sale of additional goods and/or services to individuals visiting a retail outlet for that reason.

O'Brien does not disclose that the individuals are known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet for pick up or return of a product. However, in Galler, the individuals who choose Depot Delivery presumably make it known to an administrator or supplier (and at a minimum would have to make it known to a database) that they will be visiting a specific retail outlet, apparently within a specific time frame, for pick up or return of a product shipped from a seller unrelated by ownership to that specific retail outlet. Furthermore, the fact of individuals being known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet does not ipso facto change targeting marketing to them. There is no limitation that the administrator or supplier provides information to a marketing entity, only that the administrator or supplier knows information. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the individuals to be known in advance by an administrator or supplier to be visiting within a future time period a specific retail

outlet for pick up or return of a product, for the obvious advantage of arranging for them to pick up or return the product.

As per claim 7, Galler teaches that the individual visiting the retail outlet is the same individual who ordered the product (see five paragraphs beginning from "PackageNet, a Fairfield, Iowa, company"). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the individual visiting the retail outlet to be the same individual who ordered the product, for the obvious advantage of marketing to individuals in this common situation.

As per claim 8, O'Brien discloses target marketing to the individual before, during, or after visiting the retail outlet (Abstract; columns 3 and 4).

As per claim 9, O'Brien discloses that the step of target marketing comprises transmitting a message customized to the individual or to a class of individuals based upon information known about the individual (Abstract; column 3 and 4; column 13, lines 36-51).

As per claim 12, O'Brien discloses that the step of transmitting a message comprises one-way communicating with the individual (especially column 13, lines 36-51).

As per claim 13, O'Brien discloses that the step of one-way communicating is accomplished using physical mail/parcel shipment (column 13, lines 36-51).

As per claim 14, O'Brien discloses that the target marketing is customized based on information about the individual (Abstract; columns 3 and 4).

As per claim 15, O'Brien discloses that information about the individual is voluntarily provided by the individual (column 3, lines 53-62; column 4, lines 3-8).

As per claim 21, O'Brien discloses providing a free gift or item or service to the customer (Abstract; column 13, lines 36-51). O'Brien does not expressly disclose that this is done to motivate the individual to voluntarily provide individual information, but does disclose determining whether the individual qualifies to receive a coupon based on such factors as age, residence location, or income level (column 3, lines 58-62), and that this determination is based on information previously provided by the individual (column 4, lines 3-8). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to motivate the individual to voluntarily provide individual information by providing a free gift or item or service to the individual/customer, for the obvious advantage of causing increased numbers of individuals to provide information.

As per claims 25, 26, and 28, O'Brien discloses that individual information is sold or exchanged to a third party, and used by that third party (column 13, lines 36-51), from which it inherently follows that the information is provided to the third party.

As per claim 27, O'Brien discloses target marketing to the individual (Abstract; column 13, lines 36-51).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. Neither O'Brien nor Galler discloses that the administrator is the same as the marketing entity, but official notice is taken that it is well known for marketing entities (retail outlets) to

know in advance that individuals will be visiting within a future time period. (An example with which Examiner has considerable personal experience is the knowledge acquired by a bookstore employee in a conversation like the following: "Mr. Rosen, the book you ordered has come in. We can hold it ten days." "Thanks, I'll come by after work to pick it up.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the administrator to be the same as the marketing entity, as an obvious consequence of the information often possessed by marketing entities.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. Neither O'Brien nor Galler discloses that the administrator is different from the marketing entity, but official notice is taken that it is well known for administrators different from a marketing entity to know in advance that an individual will visit within future time period a specific retail outlet. (For example, an individual employed by a business may say to an administrator, "We're running out of paperclips. I'm going to Smith's Stationery Store this afternoon to get more.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the administrator to be different from the marketing entity, for the obvious advantage of marketing to individuals whose visits to retail outlets are known in advance to administrators different from marketing entities. Be it noted that claim 3 does not specify what the administrator administers, nor recite any requirement that the administrator provide information to the retail outlet or the marketing entity.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. Neither O'Brien nor Galler discloses that the administrator is the same as the retail outlet, but official notice is taken that it is well known for retail outlets to know in advance that individuals will be visiting within a future time period. (An example with which Examiner has considerable personal experience is the knowledge acquired by a bookstore employee in a conversation like the following: "Mr. Rosen, the book you ordered has come in. We can hold it ten days." "Thanks, I'll come by after work to pick it up.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the administrator to be the same as the retail outlet, as an obvious consequence of the information often possessed by retail outlets.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. Neither O'Brien nor Galler discloses that the administrator is different from the retail outlet, but official notice is taken that it is well known for administrators to know in advance that an individual will visit within future time period a specific retail outlet. (For example, an individual employed by a business may say to an administrator, "We're running out of paperclips. I'm going to Smith's Stationery Store this afternoon to get more.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the administrator to be different from the retail outlet, for the obvious advantage of marketing to individuals whose visits to retail outlets are known in advance to administrators different from the retail outlet. Be it noted that claim 5 does

not specify what the administrator administers, nor recite any requirement that the administrator provide information to the retail outlet or the marketing entity.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. Neither O'Brien nor Galler discloses that the individual visiting the retail outlet is picking up a product ordered by another individual, but official notice is taken that it is well known for one individual to pick up a product ordered by another, either because the two individuals are living or working in close association ("Honey, since you're going downtown, would you mind picking up a package for me?"), or because one individual has ordered a product for another (e.g., A orders a product as a birthday present for B, who is not home when the mailman brings it, causing the mailman to leave a note inviting B to visit the post office to pick up the package containing the product). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the individual visiting the retail outlet to be picking up a product ordered by another individual, for the obvious advantage of marketing to individuals in this common circumstance.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 9 above, and further in view of official notice. As per claim 10, O'Brien does not disclose that the step of transmitting a message comprises communicating with the individual using an interactive device, but official notice is taken that it is well known to communicate with individuals using interactive devices, and in particular (as per claim 11) using telephoning, instant

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messaging, and communicating via the Internet. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to transmit a message using an interactive device (as per claim 10), and for this to comprise one from the group of telephoning, instant messaging, and communicating via the Internet (as per claim 11), for the obvious advantage of communicating with the individual by standard, widely available means.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 14 above, and further in view of official notice. O'Brien does not expressly disclose that the information about the individual is based upon identification of the individual by at least one from the group of telephone number, Internet address, physical address, cable address, and satellite address (although O'Brien discloses qualifying an individual to receive a coupon based on residence location [column 3, lines 58-62], putting an individual's name on a mailing list, and mailing product samples to the individual [column 13, lines 36-51], implying use of at least a physical address). However, official notice is taken that it is well known to identify individuals by telephone number, physical address, Internet address, and other address information. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have the information about the individual based upon identification of the individual by at least one from the group of telephone number, Internet address, physical address, cable address, and satellite address, for the obvious advantages of sending packages, telephone messages, etc., to the correct addresses, and distinguishing individuals with the same or similar names.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 14 above, and further in view of official notice. O'Brien does not expressly disclose that the individual's information is extracted from public records using the individual's identification (as per claim 17), or that the individual's information is extracted from third party information sources using the individual's identification (as per claim 18), but official notice is taken that it is well known to extract information on an individual from public records and other third party information sources using individual identification. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to extract the individual's information from public records and/or third party information sources using the individual's identification, for the obvious advantage of obtaining relevant information about the individual.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 14 above, and further in view of official notice. As per claim 19, O'Brien does not disclose that the individual's information is extracted by tracking technology, and as per claim 20, O'Brien does not disclose that the tracking technology is internet "cookie" technology; but official notice is taken that it is well known to extract information using Internet "cookie" technology. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have the individual's information extracted by tracking technology, and in particular, by Internet "cookie" technology, for the obvious advantage of obtaining information by standard, widely used means.

Claims 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 14 above, and further in view of official notice. As per claim 22, O'Brien discloses providing a free gift or item or service to the customer as target marketing (Abstract; column 13, lines 36-51). O'Brien does not expressly disclose that the providing is done to motivate the individual to voluntarily accept target marketing, but official notice is taken that it is well known to motivate individuals to voluntarily accept target marketing. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to motivate the individual to voluntarily accept target marketing by providing a free gift or item or service to the individual/customer, for the obvious advantages of causing increased numbers of individuals to accept target marketing, and avoiding ill will and possible legal liability for, for example, making unwanted telephone calls or e-mails.

As per claim 23, O'Brien does not disclose the individual consenting to receive target marketing, but official notice is taken that it is well known for individuals to consent to receive target marketing. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have the individual consent to receive target marketing, for the obvious advantages of concentrating target marketing on those who consent, and would therefore be more likely to buy the advertised goods and services, and avoiding the ill will and possible legal liability arising from making unwanted telephone calls, etc.

As per claim 24, O'Brien does not disclose selling or exchanging to a third party the customer agreement to accept target marketing, but official notice is taken that it is

well known to sell or exchange valuables to third parties, and in particular to sell customer information, e.g. mailing lists, credit ratings, etc. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to sell or exchange to a third party the customer agreement to accept target marketing, for the obvious advantage of profiting from the sale or exchange.

Claims 29, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien and Galler as applied to claim 1 above, and further in view of official notice. As per claim 29, neither O'Brien nor Galler discloses further identifying the future time period during which the individual will visit the specific retail outlet, but official notice is taken that it is well known to identify the future time period during which an individual will visit a specific retail outlet. (An example with which Examiner has considerable personal experience is the identification of a time period to a bookstore employee in a conversation like the following: "Mr. Rosen, the book you ordered has come in. We can hold it for you for ten days." "Thanks, I'll come by this evening after work to pick it up.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to include identifying the future time period during which the individual will visit the specific retail outlet, for the obvious advantage of persuading the retail outlet to continue holding the product for the individual.

As per claim 30, neither O'Brien nor Galler expressly discloses determining the future time period by estimating the time for a product to become available to the individual at the retail outlet, but official notice is taken that it is well known to estimate

the time for a product to become available to an individual at a retail outlet (e.g., "We can order that for you, sir; it will probably take about three days to arrive.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to determine the future time period by estimating the time for a product to become available to the individual at the retail outlet, for the obvious advantage of providing the individual with a time to come to the retail outlet, and not annoying him by having come to the retail outlet for a product which was not yet available, or wait unreasonably long after the product had become available.

As per claim 33, official notice is taken that it is well known for the future time period to be determined by the retail outlet. (In the example of the given in rejecting claim 29, the retail outlet determines to hold a book for a particular time period.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the future time period to be determined by the retail outlet, for the obvious advantage of making the future time period compatible with the retail outlet's convenience.

Claim 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien, Galler, and official notice as applied to claim 29 above, and further in view of articles on the PackageNet web site as of April 20, 1999 (obtained through the Wayback Machine, web.archive.org). Neither O'Brien nor Galler discloses the step of providing motivation for an individual to select for product pickup one retail outlet over another retail outlet, but PackageNet teaches this (under "PackageNet Services," page 1, and the "Find the PackageNet Locations Nearest You" webpage), the motivation being to

find a shipping/return site convenient to the individual (as per claim 34). This also meets the limitation of claim 35(e), providing the customer the opportunity to select the most convenient retail outlet in which to pick up or return a product from among a plurality of outlets. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to provide motivation for an individual to select for product pickup one retail outlet over another retail outlet (as per claim 34), and provide the customer the opportunity to select the most convenient retail outlet in which to pick up or return a product from among a plurality of outlets (as per claim 35), for the obvious advantage of encouraging an individual to use the service by providing a convenient location.

Claims 36-40

Claims 36, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "Babbage's Expands Online," hereinafter "Babbage's," in view of Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") and official notice. As per claim 36, "Babbage's" discloses a method for target marketing to individuals known in advance to be visiting a specific retail outlet, and discloses notifying an individual by telephone to visit the retail outlet to pick up a product, after receiving information from the individual via a computer network (see especially paragraph beginning "Site also has links"), from which (a) identifying, using a computer, the individual intending to visit the retail outlet to pick up or return a product is inherent; "Babbage's" also discloses directing target marketing to the individual before, during, or after visiting the retail outlet (see whole article).

"Babbage's" does not disclose that the individuals are known in advance to be visiting within a particular future time period a specific retail outlet, does not disclose that the individuals are visiting the retail outlet to pick up or return a product shipped from a seller unrelated by ownership to that specific retail outlet, and does not disclose (b) identifying, using a computer, the future time period during which the individual will visit the specific retail outlet, but Galler teaches providing pick-up and return services inside stores of a number of chains, presumably unrelated by ownership to the e-commerce merchants who sell the products delivered to those stores, with information about pick-up and/or return being provided via a computer network (see five paragraphs beginning from "PackageNet, a Fairfield, Iowa, company"). Furthermore, official notice is taken that it is well known for retail outlets to know in advance that individuals will be visiting within a particular future time period, and identify the time period. (An example with which Examiner has considerable personal experience is the knowledge acquired by a bookstore employee in a conversation like the following: "Mr. Rosen, the book you ordered has come in. We can hold it ten days." "Thanks, I'll come by after work to pick it up.") Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify, using a computer, the future time period during which the individual would visit the specific retail outlet, for the obvious advantage of setting a limit to the time during which the product must be kept at the retail outlet without being available for sale to others; and it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify an individual intending to visit the retail outlet to pick up or return a

product shipped from a seller unrelated by ownership to that specific retail outlet, for the obvious advantage of profiting from the sale of additional goods and/or services to individuals visiting a retail outlet for that reason.

As per claim 37, "Babbage's" discloses compiling individual information to enhance the effectiveness of the target marketing (see especially the paragraph beginning "Site is one of the most technically advanced").

As per claim 40, "Babbage's" discloses that the individual may be motivated to provide information (see especially the paragraph beginning "Site is one of the most technically advanced"), and that said motivation may comprise (j) providing the individual/customer with product return services (see paragraph beginning "Site also has links").

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Babbage's," Galler, and official notice as applied to claim 37 above, and further in view of Edelstein ("Till Death Do You Part . . ."). As per claim 38, "Babbage's" does not expressly disclose that the step of target marketing comprises transmitting a message customized to the individual (as opposed to the individual's parents) based upon information known about the individual, but doing this is well known, as taught, for example, by Edelstein (paragraph beginning "Some of us may still remember"). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have the step of target marketing comprise transmitting a message customized to the individual based upon information known about the individual, for the stated advantage of leading to additional sales.

As per claim 39, "Babbage's" discloses that individuals are notified by telephone, implying that the seller possesses the individuals' telephone numbers, and Edelstein teaches calling or mailing cards to customers about whom information is maintained (paragraph beginning "Some of us may still remember"). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the information about the individual to be based upon the identification of the individual by at least one from the group of telephone number, Internet address, physical address, cable address, and satellite address, for the obvious advantage of enabling the individual to be contacted for notification of product availability and targeted marketing.

Claim 41

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al. (U.S. Patent 5,832,457) in view of Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") and official notice. O'Brien discloses a method of creating target marketing opportunities, the method comprising: (b) compiling information on an individual who will visit a retail outlet (Abstract; compiling information is held to be inherent from the existence of a database of such information); and (c) directing target marketing to the individual before, during, or after visiting the retail outlet (Abstract; columns 3 and 4), and discloses use of computers for compiling information (Figure 1; column 5, line 19, through column 6, line 15). O'Brien does not disclose that the individuals are known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet for pick up or return of a product. However, in

Galler, the individuals who choose Depot Delivery presumably make it known to an administrator or supplier (and at a minimum would have to make it known to a database) that they will be visiting a specific retail outlet, apparently within a specific time frame, for pick up or return of a product. Furthermore, official notice is taken that it is well known for administrators or suppliers at retail outlets to know in advance that individuals will be visiting within a future time period. (An example with which Examiner has considerable personal experience is the knowledge acquired by a bookstore employee, a supplier of books, in a conversation like the following: "Mr. Rosen, the book you ordered has come in. We can hold it ten days." "Thanks, I'll come by after work to pick it up."). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to identify individuals known in advance by an administrator or supplier to be visiting within a future time period a specific retail outlet for pick up or return of a product, for the obvious advantage of directing target marketing profiting to them, and profiting from resulting sales.

Allowable Subject Matter

Claims 31 is rejected under 35 U.S.C. 101 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (with the objection to claim 1 and its dependents corrected in the rewriting process).

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, O'Brien et al. (U.S. Patent 5,832,457), discloses

a method of creating target marketing opportunities to individuals, meeting some of the limitations of claim 1 and its dependents. Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") teaches other limitations, and the limitations of claim 29 and 30 are considered obvious in view of well-known commercial procedure, as set forth above. Such steps as identifying the method of shipment and calculating the expected delivery time are also believed to be well known. However, neither O'Brien, Galler, nor any other prior art of record discloses calculating product pick-up time based upon individual experience with that specific individual or with a class of individuals. There may well have been cases of people doing this, but even if there are, they have not been documented, and there is in any event a lack of a teaching to motivate combining this step with the disclosures of O'Brien, Galler, and such other prior art as might be used to support the obviousness of claims 29 and 30.

Claims 32 is rejected under 35 U.S.C. 101 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 32 is allowable on essentially the same grounds as claim 31, step (b) of claim 32 being the same as step (e) of claim 31.

Response to Arguments

Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive. Applicant argues that claim 1 distinguishes over O'Brien in that in

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O'Brien, the individual is known in advance to be visiting a specified retail outlet for pickup or return of a product shipped from a seller unrelated by ownership to that retail outlet. While Examiner agrees that O'Brien does not disclose this feature, Galler was relied upon in making the rejection. Applicant argues that in the PackageNet system described by Galler, there is no teaching that marketing information may be provided to the retail outlets at which people pick up or return products shipped from unrelated sellers. Examiner replies that even if this would be grounds for allowing a more specific claim, a point on which he does not, at present, make any judgment, it does not provide grounds for allowing claim 1, because there is no limitation that the administrator or supplier provides information to a marketing entity, only that the administrator or supplier knows in advance that the individuals will be visiting a specific retail outlet. The claim is met by an administrator (who might administer anything) merely possessing this knowledge, with no requirement that the administrator provide the information to the retail outlet. It is required only that someone or something provide individual information to a marketing entity, which does not have to be the retail outlet, for target marketing before, during, or after visiting the retail outlet.

Regarding claim 27, applicant writes, "The O'Brien patent neither teaches nor suggests using information gathered before the individual visited the store to target market[,] and these features are found in claim 27." In fact, claim 27 merely states, "The method of claim 14 further including the step of target marketing to the individual," while claim 14 only recites, "The method according to claim 1 wherein the target marketing is customized based upon information about the individual," without saying

when the information was gathered. Applicant's arguments depend on limitations which are not set forth in the claims.

Regarding claims 36-40, Examiner has responded to Applicant's amendment by relying on Galler as well as official notice as a secondary reference in combination with the Babbage article. This is held to render moot Applicant's arguments; the Babbage article does not teach shipping products from a seller unrelated by ownership to the specific retail outlet, but Galler's article teaches this. Unchallenged official notice was and is taken that it is well known for retail outlets to know in advance that individuals will be visiting within a particular future time period, and identify the time period; while the Babbage article does not disclose this, claim 36 does not recite any step of marketing to individuals known in advance to be visiting within a particular future time period that would not also be applicable to individuals merely thought likely in advance to be visiting within a not very definite future time period, a situation which would arise from the notification disclosed in the Babbage article.

New claim 41 is rejected on grounds similar to those relied upon in rejecting claim 1, as set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al. (U.S. Patent 6,754,636) disclose purchasing systems and methods wherein a buyer takes possession at a retailer of a product purchased using a communication network.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

December 29, 2004